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John V. Manley, Reg. No. 38,171

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of

Inventor: Jean Paul Marcade, et al.

Serial No. 09/777,274

Filed: February 5, 2001

For: BIFURCATED GRAFT WITH AN
INFERIOR EXTENSION

Date: July 21, 2006

Examiner: David Willse

Group Art Unit: 3738

Client ID/Matter No. ENDOV-54735

REPLY TO EXAMINER'S ANSWER

MS: Appeal Brief Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated May 25,
2006. Please charge any fee due in connection with the filing of this paper to our Deposit
Account No. 06-2425.

I. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total Number of Claims in the Application

The claims in the application are: Claims 67-72 and 74-82

B. Status of All of the Claims

Each of pending claims 67-72 and 74-82 stand as finally rejected under 35 U.S.C.

§ 102(e).

C. Claims on Appeal

The claims on appeal are each of pending claims 67-72 and 74-82.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 67-72 and 74-82 were improperly rejected under 35 U.S.C. § 102(e) as being anticipated by Martin.

III. ARGUMENT

In the Examiner's Reply dated May 25, 2006, the Examiner characterized the teachings of the Martin patent as being anticipatory of the subject matter recited in claims 67-72 and 74-82. In particular, the Examiner stated that "the extender 18 is sized such that it is certainly *capable* of mating with the longer leg 6, even though such was not the intent." Moreover, the Examiner stated specifically with regard to claims 70 and 82 that the superior end 5 disclosed in the Martin reference is "*capable* of being placed within an abdominal aorta of a small mammal, with the first leg 6 being placed in an iliac artery, even though such was not the intent." Additionally, in response to the arguments set forth in the Appellant's Brief, the Examiner stated that "While Martin does not teach or suggest mating or engaging the extender 18 to longer leg 6, the current claims are not directed towards a surgical procedure or process but instead are drawn to a device in which the actual mating of the longer leg to the extender is *not* positively recited." The Examiner further stated that while features of an apparatus may be recited functionally "the apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP §2114)"

Accordingly, from the foregoing, it appears that it is the form in which the subject matter is recited in claims 67-72 and 74-82, rather than the subject matter itself, which the Examiner has found to be unpatentable. That is, the Examiner appears to intimate that if the "actual mating of the longer leg to the extender" is positively recited in the claims, then the claims might be deemed allowable over the cited art. Moreover, it appears from the Examiner's Answer that if the concept of an extender being "configured to mate with the first leg after the body is placed in vasculature" was in the mind of the Examiner cast in structural rather than functional language, then the pending claims might also be deemed allowable. It is respectfully submitted, however,

that the novel subject matter recited in the pending claims is indeed presented in a form which is patentable.

First, it is respectfully submitted that the recitation of "configured to mate with the first leg after the body is placed in vasculature" is a structural limitation which distinguishes the claims from the cited art. Further, even if such language is not considered to be structural in nature, the Appellants nevertheless submit it is functional language that can and should be considered in determining the patentability of the claims.

According to the American Heritage Dictionary, the term "configure" means to form or shape. Clearly, the form or shape of a device is indeed a structural feature. Moreover, such a structural feature is clearly not taught by the cited Martin patent since by the Examiner's own admissions it was not the intent of the Martin patent to size extender 18 so that it was capable of mating with the longer leg 6, as is required by each of pending claims 67-72 and 74-82. Moreover, by the Examiner's own admission, the superior end 5 of Martin was not intended to be sized or configured to fit an aorta-iliac segment as is required by claims 70 and 82 (recited body so sized). Therefore, it is respectfully submitted that the pending claims recite structural subject matter which is allowable over the cited Martin patent.

Moreover, even if the phrase "configured to mate with the first leg after the body is placed in vasculature" is considered to be marginally functional in nature, it is believed to be highly significant that the more recent view in patent law is that functional language in claims is not objectable per se so long as it avoids the problems of undue breadth and vagueness. In this regard, one might analogize the present situation to the thrust of MPEP 2111.04 which acknowledges the limiting effect of "adapted to" clauses. Furthermore, since the pending claims have not been rejected under 35 U.S.C. § 112, the only remaining question under the current

view is whether the recitation of the "configured to" language is found inherently in the cited Martin patent. Here the Examiner has not indicated that the recitation of an extender being "configured to mate with the first leg after the body is placed in vasculature" was inherently found in the cited art. As such, it is submitted that each of pending claims 67-72 and 74-82 are allowable over the cited art on this basis as well.

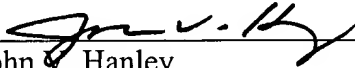
On the other hand, in the event the Examiner's use of the phrase "is capable of" might be interpreted as relating to the concept of inherency, it is respectfully submitted that the subject matter recited in the claims is clearly not inherent in view of the teachings of Martin. Significantly, for there to be inherency according to MPEP § 2112, the allegedly inherent characteristic must necessarily flow from the teachings of the applied prior art. In fact, the MPEP states that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" and that inherency "may not be established by probability or possibilities." Furthermore, the MPEP states that "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Since it is not the intent of the Martin patent to configure an extender **18** to be sized to mate with a longer leg **6** and further since it is not the intent of the Martin patent to configure a superior end **5** to be sized to be placed within an abdominal aorta, it is respectfully submitted that the subject matter recited in the pending claims is not inherently taught by the cited Martin reference and thus, it is believed that claims 67-72 and 74-82 define allowable subject matter.

CONCLUSION

For all the reasons stated above, Appellants respectfully submit that the Examiner has erred in rejecting claims 67-72 and 74-82. It is respectfully requested that the Board reverse the rejection of these claims and thus, pass pending claims 67-72 and 74-82 to issue.

Respectfully submitted,

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